IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)
	)
Donald E. Smith	) Group Art Unit: 3629
	)
Application No.: 10/700,028	) Examiner: Ouellette, Jonathan P.
	)
Filed: November 3, 2003	)
	)
For: METHOD AND SYSTEM FOR	)
PROVIDING A COMMUNITY	)
OF INTEREST SERVICE	)

APPEAL BRIEF

Mail Stop: APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

      This Appeal Brief is filed under Rule 41.37, appealing the final decision of the Examiner

dated March 5, 2009 and is further responsive to the Advisory Action dated June 24, 2009. A

Notice of Appeal was filed on July 6, 2009. Each of the topics required by Rule 41.37 is

presented herewith and labeled in accordance therewith. Only one copy of this Appeal Brief is

required, in accordance with MPEP §1205.02.

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I. REAL PARTY IN INTEREST

The real party in interest of the present application, solely for purposes of identifying and avoiding potential conflicts of interest by board members due to working in matters in which the member has a financial interest, is Verizon Communications Inc. and its subsidiary companies, which currently include Verizon Business Global, LLC (formerly MCI, LLC) and Cellco Partnership (doing business as Verizon Wireless, and which includes as a minority partner affiliates of Vodafone Group Plc). Verizon Communications Inc. or one of its subsidiary companies is an assignee of record of the present application.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present application of which the

Appellant is aware.

III. STATUS OF CLAIMS

Claims 1-7 and 9-18 are pending in the application and all stand finally rejected. Claim 8 was previously canceled without prejudice or disclaimer.

Claims 1-7 and 9-18 are the subjects of this appeal.

IV: STATUS OF AMENDMENTS

Subsequent to the final Office Action of March 5, 2009, (hereinafter "final Office Action"), Appellant filed an after-final Reply under 37 C.F.R. §1.116 on June 5, 2009 but did not amend the claims. The last amendment in this application was filed on December 5, 2008 responsive to a non-final office action dated September 5, 2008. Accordingly, there are no outstanding amendments in this application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following summary of the presently claimed subject matter indicates that certain portions of the specification (including the drawings) provide examples of embodiments of elements of the claimed subject matter. It is to be understood that other portions of the specification not cited herein may also provide examples of embodiments of elements of the claimed subject matter. It is also to be understood that the indicated examples are merely examples, and the scope of the claimed subject matter includes alternative embodiments and equivalents thereof. References herein to the specification are thus intended to be exemplary and not limiting. Appellant maps all <u>independent</u> claims[1] to the drawings and/or Specification, as follows:

1. A method for connecting no more than a plurality of customers, (e.g., 106A, B, C, D in Fig. 1) using a domain accessible through a communications network (e.g., 120 in Fig. 1), each of said plurality having a billing address and an account associated with a service provider (e.g., telco 100 in Fig. 1), said service provider communicatively linked to said domain, said method comprising:

notifying said each of said plurality about said domain by including information in a billing statement for said each of said plurality; (e.g., 202, 204, 206 in Fig. 2 and at least Specification ¶'s [0029] and [0030] and [0040])

providing said each of said plurality with access to said domain; (e.g., 208 in Fig. 2, 302 & 304 in Fig. 3 and at least Specification ¶'s [0030] - [0032] and [0040])

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[1] All dependent claims stand or fall with their respective independent claims.

providing said each of said plurality with a customer profile questionnaire; (e.g., 306 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

receiving responses to said questionnaire from at least a portion of said plurality of customers; (e.g., 308 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

receiving an inquiry about a community of interest (COI) from one customer in said portion; (e.g., 402 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

determining existence of said COI with which other customers in said portion are associated; (e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

sending a generated status message to said other customers, if said COI exists, as confirmation that said one customer has joined said COI; (e.g., 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040])and

allowing at least a subset of said portion of said plurality of customers giving common answers to said questionnaire, to communicate with each other using said domain while not disclosing true identity of each customer of said subset to others of said plurality, said subset comprising said one customer and said other customers. (e.g., 414 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

9. A system for allowing no more than a plurality of customers (e.g., 106A, B, C, D in Fig. 1) to communicate over a network (e.g., 120 in Fig. 1), said system comprising:

a service provider (e.g., telco 100 in Fig. 1 and at least Specification ¶ [0024]) having an account (e.g., at least Specification ¶'s [0025] - [0026]) with each of said plurality;

a domain associated with said service provider; (e.g., 208 in Fig. 2 and at least Specification ¶'s [0030] - [0031] and [0040])

billing means controlled by said service provider for invoicing each said account; (e.g.,

202 in Fig. 2 and at least Specification ¶'s [0029] - [0030] and [0040])

notification means associated with said billing means for informing said each of said

plurality about said domain and for providing said each of said plurality with a customer profile

questionnaire; (e.g., 202 in Fig. 2 and at least Specification ¶'s [0029] - [0030] and [0040])

means for receiving responses to said questionnaire (e.g., 306, 308, 310 in Fig. 3 and at

least Specification ¶'s [0032] and [0040]) from at least a portion of said plurality and for

allowing at least a subset of said portion of said plurality giving common answers to said

questionnaire to communicate with each other (e.g., 414 in Fig. 4 and at least Specification ¶

[0034] and [0040]) using said domain, wherein said receiving and allowing means includes

means for receiving an inquiry (e.g., 402 in Fig. 4 and at least Specification ¶'s [0034] and

[0040]) about a community of interest (COI) from one customer of said subset, means for

determining existence of said COI with other customers of said subset belonging to said COI,

(e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) and means for sending a

generated status message (e.g., 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) to

said other customers as confirmation that said one customer has joined said COI; and

a server associated with said domain for allowing said each of said subset to access said

domain upon authentication. (e.g., 102 in Fig. 1 and at least Specification ¶ [0024]; and e.g., Fig.

6 and at least Specification ¶'s [0036] - [0040]).

11. A computer-readable medium (e.g., 604, 606, 608 in Fig. 6 and at least Specification

¶ [0037]) containing a plurality of instructions that, when executed by at least one processor,

(e.g., 602 in Fig. 6 and at least Specification ¶'s [0036] - [0037] and [0040]) causes said at least

one processor to perform a method for inter-connecting through a communications network (e.g.,

120 in Fig. 1) no more than a plurality of customers (e.g., 106A, B, C, D in Fig. 1) who are

associated with a service provider (e.g., telco 100 in Fig. 1 and at least Specification ¶ [0024]),
said method comprising:

providing each of said plurality of customers with a customer profile questionnaire; (e.g.,
306 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

receiving responses to said questionnaire from at least a portion of said plurality of
customers; (e.g., 308 in Fig. 3 and at least Specification ¶'s [0032] and [0040])

allowing a subset of said portion of said plurality of customers giving common answers
to said questionnaire to have access to a domain associated with said service provider; (e.g., 414
in Fig. 4 and at least Specification ¶'s [0034] and [0040])

accepting data from at least one of said subset of said portion of said plurality of
customers, (e.g., 504-514 in Fig. 5 and at least Specification ¶'s [0035] and [0040])

verifying a true identity of said at least one of said subset of said portion of said plurality
of customers based upon at least a portion of said data; (e.g., 504 in Fig. 5 and at least
Specification ¶'s [0035] and [0040])

mapping said true identity to an alias associated with said at least one of said subset of
said portion of said plurality of customers; (e.g., 512 in Fig. 5; 410 in Fig. 4; and at least
Specification ¶'s [0034] - [0035] and [0040])and

allowing others of said subset of said portion of said plurality of customers with access to
said domain to have access only to said alias while keeping said true identity in confidence; (e.g.,
410, 412, 414 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

wherein said at least one customer of said subset inquires about a community of interest
(COI) (e.g., 406 in Fig. 4 and at least Specification ¶'s [0034] and [0040]), said COI is
determined to exist with certain customers of said subset belonging to said COI, (e.g., 406 in Fig.
4 and at least Specification ¶'s [0034] and [0040]) and a status message is generated and sent to

said certain customers as confirmation that said at least one inquiring customer has joined said

COI (e.g., 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040]).

16. A data display (e.g., 700 in Fig. 7 and at least Specification ¶'s [0041] - [0044]) for

displaying information about a domain to a customer associated with a service provider, said

customer having been notified about an address associated with said domain by said service

provider by way of a billing statement (e.g., 202, 204, 206 in Fig. 2 and at least Specification ¶'s

[0029] - [0031] and [0040]) , said domain being made available to said customer for facilitating

communication with persons having a common interest with said customer, said data display

comprising:

a logon field for receiving input data from said customer, said input data for establishing

an identity of said customer; (e.g., 707, 708 in Fig. 7 and at least Specification ¶'s [0040] -

[0044])

an alias field for displaying an alias associated with said customer, said alias further

being made available to persons having access to said domain and sharing said common interest

with said customer; (e.g., 710 in Fig. 7 and at least Specification ¶'s [0040] - [0044]) and

a selection field (e.g., 712 in Fig. 7 and at least Specification ¶'s [0040] - [0044]) for

allowing said customer to choose a topic of interest, said topic of interest (e.g., 712 in Fig. 7 and

at least Specification ¶'s [0040] - [0044]) being identified by said customer responding to

questions in a customer profile questionnaire (e.g., 306, 308 in Fig. 3 and at least Specification

¶'s [0032] - [0033] and [0040])presented by said service provider to said customer on said data

display and being linked to at least a subset of said persons sharing said common interest with

said customer, said selection field including a new group button (e.g., 712 in Fig. 7 and at least

Specification ¶'s [0040] - [0044]) for (a) creating a new group of persons including said

customer and a further subset of said subset of persons, all of whom are interested in an un-displayed topic of interest and (b) allowing a generated status message (e.g., 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040])to be sent to said customer as confirmation that said customer has successfully created said un-displayed topic of interest and has joined said new group.

17. A method for enabling each customer in a plurality of customers of a service provider to determine if other customers in said plurality have one or more interests in common with said each customer and to anonymously communicate over a network with certain of said other customers having said interests in common, said method comprising:

notifying said each customer by way of its respective billing statement from said service provider about a common domain in said network over which anonymous communication may take place and providing said each customer with a customer profile questionnaire; (e.g., 202, 204, 206 in Fig. 2 and at least Specification ¶'s [0029] - [0031] and [0040])

receiving responses to said questionnaire from at least a portion of said plurality of customers; (e.g., 306, 308 in Fig. 3 and at least Specification ¶'s [0032] - [0033] and [0040])

providing a subset of said portion of said plurality of customers giving common answers to said questionnaire with access to said domain (e.g., 314 in Fig. 3 and at least Specification ¶'s [0032] - [0033] and [0040]) and giving each in said subset access to information about said interests of said other customers (e.g., 404 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) in said subset to permit said anonymous communication between said each customer in said subset and said other customers in said subset, said anonymous communication resulting from aliases (e.g., 512 in Fig. 5 and at least Specification ¶'s [0035] and [0040]) each generated randomly by a server (e.g., 102 in Fig. 1 and 600 in Fig. 6 and at least Specification ¶'s [0036] -

[0040])for, respectively, a different one of said subset of customers, whereby said each customer

in said subset knows said aliases and not true identities of said other customers in said subset;

permitting each in said subset to inquire about a respective community of interest (COI);

(e.g., 402 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

determining existence or non-existence of said COI; (e.g., 406 in Fig. 4 and at least

Specification ¶'s [0034] and [0040])

sending, if said COI exists, a generated status message to others of said subset who

belong to said COI as confirmation that said inquiring customer has joined said COI; (e.g., 410,

412 in Fig. 4 and at least Specification ¶'s [0034] and [0040]) and

sending, if said COI does not exist, a different generated status message to said inquiring

customer signifying that said inquiring customer has successfully joined a new COI. (e.g., 408,

410, 412 in Fig. 4 and at least Specification ¶'s [0034] and [0040])

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

In the final Office Action, the following three rejections were made, and all grounds are

to be reviewed on appeal: [2]

Rejection Number One:

Claims 11 and 13-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by

Burnstein et al. (U.S. 2002/0032735 A1; hereinafter "Burnstein").

Rejection Number Two:

Claims 1-7, 9, 12, 16 and 18 are rejected under 35 U.S.C. § 103(a) as being un-patentable

over Burnstein in view of Munsil et al., U.S. Patent 5,761,650 (hereinafter, "Munsil").

Rejection Number Three:

Claims 10 and 17 are rejected under 35 U.S.C. § 103(a) as being un-patentable over

Burnstein in view of Munsil and further in view of Carter et al., (U.S. 2005/0068983 A1;

hereinafter "Carter").

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[2] As noted in the Argument section which follows, independent claims 1 and 9 shall stand or fall with claim
11. Appellant's dependent claims shall stand or fall with their independent claims. Substantive arguments are
presented for claims 11, 16 and 17.

VII: ARGUMENT

The independent claims on appeal are claims 1, 9, 11, 16 and 17. Appellant shall let the dependent claims stand or fall with their respective independent claims and let independent claims 1 and 9 stand or fall with claim 11. Therefore, the only claims for which substantive argument is presented are claims 11, 16 and 17.

SUMMARY OF THE BURNSTEIN DISCLOSURE:

Burnstein teaches apparatus, means and methods for automatic community formation for phones and computer networks. (Title) Burnstein determines commonality of subject matter based on subject matter searched by different individuals. Burnstein discloses an automatic telephone, Internet or intranet community formation system that utilizes spoken words or matching search terms. The invention utilizes wireless and wired voice communications, database and list server technology to archive and match users based upon their search terms entered into a telephone system or a search engine, Internet, intranet, extranet, local area network, wide area networked, wired, wireless or standalone computer. A community formation system refers to a means of inviting one or more persons to communicate via voice, email or other method and join in a discussion. Invitations to join would be sent via an email, SMS, instant messaging, phone, web browser, email or fax communication. The user would have control over whether he or she wanted to be invited into a community, the age of desired matches, the closeness or breadth of the matches, the duration of the community, and the type of community--voice or text. Also, users have the ability to a.) conduct joint searches and b.) jointly and severally rate the content information, websites, or other subjects, and c.) to pick settings to establish his or her actual identity or to adopt an anonymous identity. (Abstract) Importantly,

Burnstein discloses a reliance on **searches** and not on questionnaires. Further, Burnstein does **not** disclose a status message confirming an accomplished act.

SUMMARY OF THE MUNSIL DISCLOSURE:

Munsil teaches a billing system and method. (Title) Munsil discloses a bill editor, generator, messaging and insert system and method that comprise a portion of a bill production processor designed to create monthly billing statements. The statements are sent to customers which detail charges incurred over the course of a billing cycle. The bill editor and generator allow billing personnel to design a bill using static text, dynamic text and paragraph areas. Once the report/bill is defined, the report definition is stored in temporary memory for later use. The report definition file defines how the report is to appear and where the data used in the report is stored. The report generator, when subsequently run, uses the predefined report definition to retrieve data from the database and generates the report as defined by the report definition file. The bill messaging and insert system determines, based on assigned priority, criteria and weight and space limitations, the messages and notices to be included in a customer billing statement. (Abstract) Although Munsil teaches inclusion of messages on billings that it mails, the information flow is unidirectional to the customers and it does not include questionnaires in those messages for information flow from the customers to the billing entity. Further, a status message confirming an accomplished act is not disclosed.

SUMMARY OF THE CARTER DISCLOSURE:

Carter teaches a policy and attribute based access to a resource. (Title) Carter discloses techniques for controlling access to a resource based on access policies and attributes. A principal issues a request to a service for purposes of accessing a resource. The principal is authenticated and a service contract for the principal, the service, and the resource is generated.

The service contract defines resource access policies and attributes which can be permissibly performed by the service on behalf of the principal during a session. Moreover, the session between the service and the resource is controlled by the service contract. (Abstract) Customer profile questionnaires are not disclosed. Further, a status message confirming an accomplished act is not disclosed.

I. OVERVIEW:

In the following discussion, all details including all usages of reference numerals and Fig. numbers are intended to be merely examples and not to be limiting in any respect. In overview, Appellant's disclosure includes information about to how to determine which customers, e.g., a Telco's customers, share a common interest so they can register for a community of interest (COI) service based on that common interest. A database as depicted in Fig. 5 is maintained by the Telco in which customer interests 508 are included. This database is built-up in response to server 102 (depicted in Fig. 1 and detailed in Fig. 6) receiving answers to customers' questionnaires which were inserted in customers' invoices or which were on-line questionnaires. These interests 508 are associated with their respective customers, as shown in Fig. 5. Customers having overlapping or common interests can be associated within a domain by operation of server 102 shown in Fig. 1 and 600 shown in Fig. 6; such operation is depicted in the flowcharts and discussed, for example, at least in paragraph [0040].

In accordance with act 208 in Fig. 2, a customer can register for a community of interest (COI) service. Each customer in the database may perform this procedure. This is discussed in paragraph [0031]. Each customer may go to a universal resource locator (URL) associated with a COI flyer received in the mail to register for a respective desired service. The detail of this registration is disclosed in Fig. 3 and in paragraphs [0032] - [0033]. This can involve an on-line

user profile questionnaire about each customer's areas of interest and other personal information. The telco 100 COI server 102 of Fig. 1, shown in more detail in Fig. 6, and discussed in paragraphs [0036] to [0040], receives the various completed questionnaires, establishes an account for each such customer and sends logon information to the customer, after which the customer can use the respective desired COI service. This, of course, is done with respect to each customer who responds in this fashion.

In Fig. 4, per act 402, server 102 can receive an inquiry from a particular customer with respect to the area of interest selected by that particular customer. This request is processed per Fig. 4, as discussed in paragraph [0034]. For example, in act 410, server 102 selects other customers in its database with criteria that match the particular customer's profile to form a group of customers with common interest, and maps the above-noted database entries to aliases of the matching customers. In act 412, a status message is sent to the inquiring customer and to other customers having interest in common with each other and with the inquiring customer to confirm that the inquiring customer has joined the group. Stored in the database are aliases (512, Fig. 5) of customers in this particular group having common interest; these aliases include the alias for the inquiring customer. The aliases are distributed amongst the group by the server, thereby allowing group members to communicate with each other on an anonymous basis.

The detail of the database of Fig. 5 is discussed in paragraph [0035]. The server is depicted in Fig. 6 and is discussed in paragraphs [0036] - [0040]. In addition, a screenshot is depicted in Fig. 7 showing what an inquiring customer may see when attempting to join a COI group in this manner. Description of customer interaction with the screenshot is presented in paragraphs [0041] - [0044].

I. THE LAW

MPEP § 2131 states that to anticipate a claim, the reference must teach every element of

the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the …claim." *See Richardson v. Suzuki Motor Co.,* 868 F. 2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). In this instance questionnaires are not taught in Burnstein and the other references do not cure this deficiency and status messages confirming that customers have joined a COI are not taught in Burnstein and the other references do not cure this deficiency, as explained below.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (C.C.P.A. 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). KSR International Co. v. Teleflex Inc., 550 U.S. _____ (April 30, 2007). In this instance questionnaires are not taught by any of the cited references taken individually or in any reasonable combination and status messages confirming that customers have joined a COI are not taught by any of the cited references taken individually or in any reasonable combination, as explained below.

II. INDEPENDENT CLAIM 11:

(i) a status message is generated and sent to said certain customers as confirmation that said at least one inquiring customer *has joined* said COI

Claim 11 is rejected under 35 U.S.C. § 102(e) as being anticipated by Burnstein et al. Claim 11 calls for, *inter alia*, a method "wherein said at least one customer of said subset

inquires about a community of interest (COI), said COI is determined to exist with certain

customers of said subset belonging to said COI, and <u>a status message is generated and sent to</u>

<u>said certain customers as confirmation that said at least one inquiring customer *has joined* said</u>

<u>COI</u>." (emphasis added) Burnstein, paragraph 16, is cited against this limitation (Office Action,

page 3)

> [0016] The problem is that there typically needs to be a critical mass of 5-500 users to provide
> enough people to cover a wide range of questions that might be asked on any given topic. This
> invention only requires that there be as little as two people who have a similar interest. <u>Even if
> the earlier searcher is not currently looking for information on this subject this invention
> "remembers" his or her [previously-expressed] interest and automatically asks permission [of the
> earlier searcher] to make a match with someone who is interested.</u>

(Burnstein, paragraph 16, emphasis added) This section of Burnstein says that even if a previous

searcher (the "earlier" searcher) is not currently searching, the topic that was previously searched

by the previous searcher is remembered and if another searcher ("someone who is interested")

should subsequently search the same topic, or a similar topic, the previous searcher is *asked*

permission to make a match with the current searcher. The Office Action states: "Para 0016,

system automatically asks permission of *current user* to make match - equivalent to status

message." (Office Action, page 3; emphasis added) Appellant respectfully, but emphatically,

disagrees for several reasons.

    First of all, the Examiner mis-interprets to whom the query is being directed. The system

does not automatically ask permission of the *current user*. The query is being directed to the

previous searcher, not the current searcher. The above quoted passage in Burnstein says "asks

permission to make a match *with* someone who *is* interested." If the previous searcher is not

currently searching that topic, a possibility which the passage suggests, then the only party who

is interested for certain is the *current* searcher. Thus, permission must be asked of the *previous*

searcher to make a match *with* someone who *is* interested, namely, the current searcher.

Moreover, even if one takes the Examiner's unreasonable position where a current searcher is being asked to join with a previous searcher who has been dormant relative to searching this topic, *asking* permission to make a *future* match is not confirmation of a previous match made in the past, in any event.

Clearly, Appellant's recited limitation calls for "confirmation that said at least one inquiring customer has joined said COI" and this is a confirmation of a deed that has taken place. This is confirmation of a past-accomplished deed. Note the usage of past tense in the term **"has joined"** which is recited in the claim.

But, quite differently, the passage in Burnstein cited against this limitation, namely, "asks permission [of the earlier searcher who had previously expressed interest] to make a match with someone who is interested [the current searcher]" clearly refers to a match that <u>might take place in the future</u>. Perhaps, the current searcher who is interested shall eventually join and perhaps not. For example, suppose the "earlier searcher" <u>refuses permission</u> for whatever reason. In the case of only "two people" as disclosed in the above Burnstein section, the current searcher who is interested can't join a non-existent group and, therefore, shall not have joined. Indeed, to <u>ask permission</u> of "the earlier searcher" to make a match with "someone [else] who is interested" is merely making a request to join (even if there are multiple earlier searchers each of whom could refuse permission) and is certainly *not* a confirmation of a deed that has already taken place - it is not a "confirmation that said at least one inquiring customer has joined said COI" as recited in claim 11. Taking the reverse view, per the Examiner, even asking the current searcher to join doesn't read on Appellant's claim limitation because the previous searchers may have lost interest and, for those or other reasons, prevent a COI from evolving. The fundamental weakness in the Examiner's position is: **asking is not confirming**.

Because <u>asking permission to join is not a confirmation that the customer has joined</u>, Burnstein does not anticipate the subject matter recited in claim 11. Neither Munsil, cited against claims other than claim 11 to show billing statements, nor Carter, cited against claims other than claim 11 to show randomly-generated alias names, cure this deficiency in Burnstein. Accordingly, Burnstein, Munsil and Carter, taken individually or in any reasonable combination do not disclose or suggest the subject matter recited in claim 11. MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. Because Burnstein fails to do this, the 35 U.S.C § 102(e) rejection of claim 11 should be REVERSED and the claim allowed for these reasons alone.

(ii) providing each of said plurality of customers with a customer profile questionnaire

Claim 11 recites, inter alia: "providing each of said plurality of customers with a customer profile questionnaire." But, Burnstein does not disclose a questionnaire.

Appellant respectfully disagrees with the Examiner's position as expressed, for example, on pages 2-3 of the Office Action. Therein, when referring to Burnstein, Figs. 6-10, it says "providing search ability and receiving search string information is *equivalent* to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users." (emphasis added) But, receiving data to correlate users because <u>Burnstein's receiver</u> of that data (the search service/engine) wants to correlate users is <u>not</u> equivalent to receiving data to correlate users because <u>Appellant's supplier</u> of that data (the customer who wants to join) wants to correlate users.

Burnstein says: "After making a match the invention automatically invites the matched parties to join a frictionless and immediate electronic community *if they so desire*." (Burnstein, paragraph 13; emphasis added) Thus, a received search string in Burnstein carries with it a

question about the formation of an electronic community. For example, this could be a question about whether this search string is acceptable subject matter for discussion within the electronic community but, quite differently, information supplied in response to Appellant's questionnaire is always acceptable since it is *pre-approved* by the information-supplier for community discussion because that is why it is being supplied in the first place.

In other words, in Burnstein, after a search request is made, the searching party receives, and possibly is surprised or even annoyed, with an invitation to join a group whose members have also, for whatever reasons, searched the same topic. The searching party may refuse to join. Not every subject is a candidate for discussion for every searching party. Some subjects may be very private/sensitive to some individuals under certain circumstances. This is quite different from receiving a questionnaire, as Appellant discusses, to be voluntarily answered by a party who knows in advance that he/she is attempting to join a discussion group about a subject(s) of interest and who wants to discuss that subject. Common data does not necessarily imply a mutual interest in the various parties submitting that common data to discuss it. That is why Burnstein offers the option of not joining a COI: i.e., "if they so desire" as noted above.

Indeed, Appellant's questionnaire, which is to be affirmatively completed _only_ if the participant wants to participate in a discussion of a particular subject noted in the questionnaire, is quite different, *ab initio*, from a search request. Thus, contrary to the Examiner's interpretation, Burnstein's teaching of search ability is not equivalent to Appellant's teaching of sending a questionnaire.

Moreover, Burnstein itself suggests that operation of its disclosed invention is different from using a questionnaire. Referring to its paragraphs [0049] and [0050]: "However, one of the weaknesses of these existing systems is that they require users to either (1) enter a pre-defined gathering space or *answer questions* or (2) create a pre-determined profile." (Burnstein

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paragraph [0049], emphasis added) "Further, it [the Burnstein patent] provides a means and method of comparing that search with prior search terms entered by others to make a match between similar searches - *without needing to predetermine the basis for the match*." (Burnstein paragraph [0050], emphasis added).

Thus, Burnstein's view is that answering questions to predetermine the basis for the match is an alleged weakness of existing systems which Burnstein asserts has been overcome by resorting to something quite different, common search strings. Therefore, Burnstein essentially admits that it doesn't "answer questions" reinforcing Appellant's position that it does not read on "providing each of said plurality of customers with a customer profile questionnaire" as recited in claim 11. Further, Appellant submits that Burnstein's disclosed view that it has overcome a perceived weakness to "answer questions" is devoid of detail and does not read on "providing each of said plurality of customers with a customer profile questionnaire" as recited in claim 11.

In addition, Appellant submits that people ordinarily do not search <u>all</u> subjects in which they have interest. A search of a particular subject is conducted for a particular reason and a search string is focused on a specific topic. Therefore a large segment of subject matter of interest to an individual shall probably remain undisclosed and not inquired about, in accordance with the teachings of Burnstein, when using only that individual's current search string as the basis for inquiring about his/her interest in joining a community of interest (COI).

By contrast, when presenting a questionnaire, in accordance with Appellant's disclosure, a wide-ranging inquiry about subject matter of interest can be presented to that individual who is not restricted in his/her response. Thus, subjects in a wide spectrum and unrelated to each other can emerge responsive to open-ended questions in a questionnaire, as compared to a mere subset of those subjects, if not only one subject, that would be submitted for a search. Accordingly,

Appellant can offer a basis for chatting with others on virtually all non-private subjects of current interest to that individual while Burnstein does not. This example underscores the fact that the search string information and the questionnaire responses *are not equivalent* mechanisms for setting up communities of interest for conversation or interaction.

Because a customer profile questionnaire is not provided by Burnstein for reasons given above, other limitations of claim 11 are likewise not anticipated. Namely, "receiving responses to said *questionnaire* from at least a portion of said plurality of customers" and "allowing a subset of said portion of said plurality of customers giving common answers to said *questionnaire* to have access to a domain associated with said service provider" (emphases added) are also not anticipated. Neither Munsil, cited against claims other than claim 11 to show billing statements, nor Carter, cited against claims other than claim 11 to show randomly-generated alias names, cure this deficiency in Burnstein. MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. Because Burnstein fails to do this, the 35 U.S.C § 102(e) rejection of claim 11 should be REVERSED and the claim allowed for these additional reasons.

III. INDEPENDENT CLAIM 1:

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil. Claim 1 recites, *inter alia*: "sending a generated status message to said other customers, if said COI exists, as confirmation that said one customer *has joined said COI*." (emphasis added) As in claim 11, Burnstein, paragraph 16, is cited against this limitation (Office Action, page 5). In addition, claim 1 recites, *inter alia*: "providing said each of said plurality with a customer profile questionnaire." As in claim 11, referring to Burnstein, Figs. 6-10, the Office Action says "providing search ability and receiving search string information is *equivalent* to sending a questionnaire and receiving responses - in both cases data is receive [sic]

to correlate users." (emphasis added; Office Action, pg 4) Therefore, claim 1 is allowable for the same reasons as, or similar reasons to, those provided above with respect to claim 11.

IV. INDEPENDENT CLAIM 9:

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil. Claim 9 recites, *inter alia*: "means for sending a generated status message to said other customers as confirmation that said one customer *has joined said COI*." (emphasis added) As in claim 11, Burnstein, paragraph 16, is cited against this limitation (Office Action, page 5). In addition, claim 9 recites, *inter alia*: "providing said each of said plurality with a customer profile questionnaire." As in claim 11, referring to Burnstein, Figs. 6-10, the Office Action says "providing search ability and receiving search string information is *equivalent* to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users." (emphasis added; Office Action, pg 4) Therefore, claim 9 is allowable for the same reasons as, or similar reasons to, those provided above with respect to claim 11.

V. INDEPENDENT CLAIM 16:

Claim 16 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil. Claim 16 recites, *inter alia*: "allowing a generated status message to be sent to said customer as confirmation that said customer has successfully created said un-displayed topic of interest and *has joined said new group*" (emphasis added) Burnstein, paragraphs 22 and 23 are cited against this limitation (Office Action, page 8):

[0022] The initial interaction of the user with the computer or phone is to search for data. In the present embodiment of the invention, the data could be located on the computer itself, in distributed databases over a network connection, e.g., the Internet, intranet, extranet or over a telephone system. The user performs a search utilizing natural language consisting of a series of keywords, phrases, or sentences, called a "search string." Other types of search strings or search input are possible. The computer has means to pass the search string or search input to a search engine, which could be located on the computer itself or remotely on the network.

[0023] The invention will take people matched by their search string or voice in/out and if it finds a match offer them the opportunity to enter an existing community or create a new community.

> This will be a text, avatar (graphical representation) or voice chat room for instant or real-time conversation via text or speech. There could be a "bulletin board" for posting asynchronous communication. The community might contain useful links to information, goods and services. The community will provide users with user preferences to control the look, feel and functionality of the community. For example users may not want a chat room and only want a bulletin board. Users may or may not want to shop from a community. Users may or may not want the community to suggest links to information, goods and services. The invention gives users control over these details.

(Burnstein, paragraphs 22 and 23, emphasis added) The Office Action, pg 8, states: "Para 0022-0023, invitation to join or start new community sent to user if no matching community found; Figs. 1-9." Appellant submits that there is nothing in this statement and/or in Figs. 1-9 and nothing in Burnstein's paragraphs 22 and 23, or anyplace else in Burnstein, which read on "allowing a generated status message to be sent to said customer as confirmation that said customer has successfully created said un-displayed topic of interest and *has joined said new group*" as recited in claim 16 (emphasis added). Merely offering an opportunity *to* enter into an existing community or *to* create a new community refers to an event that might or might not take place in the future and, therefore, is not a status message confirming anything that has previously taken place in the past. Arguments made above for patentability of claim 11 in this regard are directly applicable here and are incorporated by reference herein. Therefore, Burnstein does not disclose or suggest the subject matter of claim 16. Munsil, cited to teach billing statements, does not cure this deficiency in Burnstein. Therefore Burnstein and Munsil, taken individually or in any reasonable combination do not disclose or suggest the subject matter of claim 16.

The Office Action has not cited Burnstein's paragraph 16 against this limitation and Appellant agrees that it should not be cited. But, even if the Office Action had done so, any rejection based on that cite would have been ineffective for reasons that are the same as, or similar to, those given above for claim 11. For at least these reasons, the 35 U.S.C § 103 (a) rejection of claim 16 should be REVERSED and the claim allowed.

Furthermore, claim 16 recites, *inter alia*: "…said customer responding to questions in a customer profile *questionnaire* presented by said service provider to said customer…" (emphasis added) The Examiner takes the same position with respect to this limitation of claim 16 that was taken with respect to the same, or a similar, limitation in claim 11. With respect to claim 16, referring to Burnstein, Figs. 6-10, he says "providing search ability and receiving search string information is *equivalent* to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users." (Office Action, pgs 7-8, emphasis added) But, receiving data to correlate users because <u>Burnstein's receiver</u> of that data (the search service/engine) wants to correlate users is <u>not</u> equivalent to receiving data to correlate users because <u>Appellant's supplier</u> of that data (the customer who wants to join) wants to correlate users. Appellant incorporates by reference herein the relevant questionnaire argument presented above for claim 11. For at least these reasons, the 35 U.S.C § 103 (a) rejection of claim 16 should be REVERSED and the claim allowed.

VI. INDEPENDENT CLAIM 17:

Claim 17 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil and Carter. Claim 17 recites, *inter alia*: (a) "sending, if said COI exists, a generated status message to others of said subset who belong to said COI as confirmation that said inquiring customer *has joined said COI*;" and (b) "sending, if said COI does not exist, a different generated status message to said inquiring customer signifying that said inquiring customer *has successfully joined a new COI*." (emphasis added)[3] Burnstein, paragraph 16 is once again cited against the (a) limitation and paragraph 23 (one of two paragraphs shown above for claim 16) is cited against the (b) limitation (Office Action, page 11) The (a) limitation recites "*has joined* said COI" and the (b) limitation recites "*has* successfully *joined* a new COI" both of which are

past events and referred to in the past tense. They are not disclosed or suggested by their respectively cited passages in Burnstein for reasons that are the same as, or similar to, those given above with respect to claims 11 and 16, respectively. Arguments made for patentability of claims 11 and 16 in this regard are directly applicable here and are incorporated by reference herein. For at least these reasons, the 35 U.S.C § 103 (a) rejection of claim 17 should be REVERSED and the claim allowed.

In addition, claim 17 recites, inter alia: "...and providing said each customer with a customer profile questionnaire." The Examiner takes the same position with respect to this limitation of claim 17 that was taken with respect to the same, or a similar, limitation in claim 11. With respect to claim 17, referring to Burnstein, Figs. 6-10, he says "providing search ability and receiving search string information is *equivalent* to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users." (Office Action, pg 10-11, emphasis added) But, receiving data to correlate users because Burnstein's receiver of that data (the search service/engine) wants to correlate users is not equivalent to receiving data to correlate users because Appellant's supplier of that data (the customer who wants to join) wants to correlate users. Appellant incorporates by reference herein the relevant questionnaire argument presented above for claim 11. For at least these reasons, the 35 U.S.C § 103 (a) rejection of claim 17 should be REVERSED and the claim allowed.

All pending dependent claims are allowable, at least for reasons based on their respective dependencies from allowable base claims.

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3 Note that "(a)" and "(b)" are designators used only in these remarks as convenient flags for discussion purposes.

CONCLUSION

Appellant respectfully requests that the Honorable Board REVERSE the final rejection of the appealed claims for the reasons given above.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No**. 07-2347** and please credit any excess fees to such deposit account.

Respectfully submitted,

/Joel Wall/
Joel Wall - Registration 25,648

Date: September 8, 2009
c/o Eddy A. Valverde, Patent Paralegal
Verizon Patent Management Group
1320 North Courthouse Road, 9th Floor
Arlington, VA 22201 - 2909
Tel: 703.351.3032
Fax: 703.351.3665
Customer No. 25,537

VIII: CLAIMS APPENDIX

1.   A method for connecting no more than a plurality of customers using a domain accessible through a communications network, each of said plurality having a billing address and an account associated with a service provider, said service provider communicatively linked to said domain, said method comprising:

notifying said each of said plurality about said domain by including information in a billing statement for said each of said plurality;

providing said each of said plurality with access to said domain;

providing said each of said plurality with a customer profile questionnaire;

receiving responses to said questionnaire from at least a portion of said plurality of customers;

receiving an inquiry about a community of interest (COI) from one customer in said portion;

determining existence of said COI with which other customers in said portion are associated;

sending a generated status message to said other customers, if said COI exists, as confirmation that said one customer has joined said COI; and

allowing at least a subset of said portion of said plurality of customers giving common answers to said questionnaire, to communicate with each other using said domain while not disclosing true identity of each customer of said subset to others of said plurality, said subset comprising said one customer and said other customers.

2.   The method of claim 1 wherein said notifying further includes mailing said billing

statement to each of said plurality.

3.   The method of claim 2 wherein said notifying further includes providing said plurality with a universal resource locator (URL), said URL for allowing said plurality access to said domain.

4.   The method of claim 1 wherein said access means includes a server associated with a URL and made available to said plurality of customers, said server facilitating access to said domain by said plurality.

5.   The method of claim 1 wherein said addresses are used in establishing said subset of said plurality.

6.   The method of claim 1 wherein said domain is only accessible to those of said plurality sharing a common interest.

7.   The method of claim 6 wherein said providing further requires that said each of said plurality enter a password to gain access to said domain.

9.   A system for allowing no more than a plurality of customers to communicate over a network, said system comprising:

        a service provider having an account with each of said plurality;

        a domain associated with said service provider;

        billing means controlled by said service provider for invoicing each said account;

notification means associated with said billing means for informing said each of said

plurality about said domain and for providing said each of said plurality with a customer profile

questionnaire;

means for receiving responses to said questionnaire from at least a portion of said

plurality and for allowing at least a subset of said portion of said plurality giving common

answers to said questionnaire to communicate with each other using said domain, wherein said

receiving and allowing means includes means for receiving an inquiry about a community of

interest (COI) from one customer of said subset, means for determining existence of said COI

with other customers of said subset belonging to said COI, and means for sending a generated

status message to said other customers as confirmation that said one customer has joined said

COI; and

a server associated with said domain for allowing said each of said subset to access said

domain upon authentication.

10.   The system of claim 9 wherein said server further comprises:

authentication means for allowing each of said one customer and said other customers of

said subset to establish its respective identity; and

associating means for mapping each said respective identity to an alias randomly-

generated and chosen by said server and associated with its respective customer of said subset,

said alias being made available to all other customers of said subset having access to said

domain, said alias further concealing true identity of said respective customer of said subset;

storage means for archiving said domain and information about said one customer of said

subset and said other customers of said subset having access to said domain; and

interaction means for allowing said other customers of said subset having access to said

domain to communicate with each other and with said one customer of said subset using their respective aliases.

11.   A computer-readable medium containing a plurality of instructions that, when executed by at least one processor, causes said at least one processor to perform a method for inter-connecting through a communications network no more than a plurality of customers who are associated with a service provider, said method comprising:

   providing each of said plurality of customers with a customer profile questionnaire;

   receiving responses to said questionnaire from at least a portion of said plurality of customers;

   allowing a subset of said portion of said plurality of customers giving common answers to said questionnaire to have access to a domain associated with said service provider;

   accepting data from at least one of said subset of said portion of said plurality of customers,

   verifying a true identity of said at least one of said subset of said portion of said plurality of customers based upon at least a portion of said data;

   mapping said true identity to an alias associated with said at least one of said subset of said portion of said plurality of customers; and

   allowing others of said subset of said portion of said plurality of customers with access to said domain to have access only to said alias while keeping said true identity in confidence;

   wherein said at least one customer of said subset inquires about a community of interest (COI), said COI is determined to exist with certain customers of said subset belonging to said COI, and a status message is generated and sent to said certain customers as confirmation that said at least one inquiring customer has joined said COI.

12.   The method of claim 11 further comprising:

notifying said plurality of customers about said domain by including information in a

billing statement associated with said service provider.

13.   The method of claim 11 further including storing said domain and information about

those of said plurality of customers having access to said domain.

14.   The method of claim 11 wherein said allowing said domain access and said allowing said

alias access include a server coupled to said communications network.

15.   The method of claim 14 wherein said at least one of said plurality of customers uses a

web browser to access said domain.

16.   A data display for displaying information about a domain to a customer associated with a

service provider, said customer having been notified about an address associated with said

domain by said service provider by way of a billing statement, said domain being made available

to said customer for facilitating communication with persons having a common interest with said

customer, said data display comprising:

a logon field for receiving input data from said customer, said input data for establishing

an identity of said customer;

an alias field for displaying an alias associated with said customer, said alias further

being made available to persons having access to said domain and sharing said common interest

with said customer; and

a selection field for allowing said customer to choose a topic of interest, said topic of interest being identified by said customer responding to questions in a customer profile questionnaire presented by said service provider to said customer on said data display and being linked to at least a subset of said persons sharing said common interest with said customer, said selection field including a new group button for (a) creating a new group of persons including said customer and a further subset of said subset of persons, all of whom are interested in an un-displayed topic of interest and (b) allowing a generated status message to be sent to said customer as confirmation that said customer has successfully created said un-displayed topic of interest and has joined said new group.

17.   A method for enabling each customer in a plurality of customers of a service provider to determine if other customers in said plurality have one or more interests in common with said each customer and to anonymously communicate over a network with certain of said other customers having said interests in common, said method comprising:

notifying said each customer by way of its respective billing statement from said service provider about a common domain in said network over which anonymous communication may take place and providing said each customer with a customer profile questionnaire;

receiving responses to said questionnaire from at least a portion of said plurality of customers;

providing a subset of said portion of said plurality of customers giving common answers to said questionnaire with access to said domain and giving each in said subset access to information about said interests of said other customers in said subset to permit said anonymous communication between said each customer in said subset and said other customers in said subset, said anonymous communication resulting from aliases each generated randomly by a

server for, respectively, a different one of said subset of customers, whereby said each customer
in said subset knows said aliases and not true identities of said other customers in said subset;

permitting each in said subset to inquire about a respective community of interest (COI);

determining existence or non-existence of said COI;

sending, if said COI exists, a generated status message to others of said subset who
belong to said COI as confirmation that said inquiring customer has joined said COI; and

sending, if said COI does not exist, a different generated status message to said inquiring
customer signifying that said inquiring customer has successfully joined a new COI.

18.   The method of claim 1 further comprising:

sending a generated status message to said one customer, if said COI does not exist, as
confirmation that said customer has successfully joined a new COI.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.